

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 1, 4, 5, 8, 9, 12, 16, 18-20, 25, 27-29, 31, 64, and 87-88 are pending.

Applicants amended claims 1 and 64 to recite "the liquid phase having a viscosity ranging from 2cP to 5cP." Support for these amendments can be found at least in the original claims and the specification at paragraph [047]. Accordingly, no new matter has been added.

**II. INTERVIEW**

Applicants thank Examiner Brown and Supervisor Richter for granting a telephonic interview on December 19, 2008. The double patenting rejections of record were discussed. A potential rejection under 35 U.S.C. § 103 in view of *Osman et al.* WO 00/72821 (International Application Published Under the PCT, Published 12/07/2000) was also discussed. The substance of the interview is captured by this response.

**III. The instant claims are not obvious in view of *Osman et al.***

As discussed in the interview, Applicants respectfully submit that claims 1, 4, 5, 8, 9, 12, 16, 18-20, 25, 27-29, 31, 64, and 87-88 are not obvious under 35 U.S.C. § 103 in view of *Osman et al.* WO 00/72821 (International Application Published Under the PCT, Published 12/07/2000).

Applicants respectfully submit that the *Osman* reference cannot form the basis of a *prima facie* case of obviousness because it does not teach or suggest all the claim limitations. M.P.E.P. § 2141. Specifically, it is silent as to the viscosity of the liquid

phase of the foam and fails to suggest that the viscosity of the liquid phase is related in any way to a desirable foam. While *Osman* may disclose the use of glycerol, which is one of the at least one viscosity enhancing agents of instant claim 16, as a means of “stabilizing” a foam, there is no teaching of a desired foam resulting from a specific viscosity of the liquid phase and no suggestion of the viscosity range claimed herein.

Furthermore, the claimed invention is not obvious in view of *Osman* because there is no suggestion or motivation in the prior art to combine the claimed limitations. The fact that the reference could be modified does not render the modification obvious unless the prior art also suggests the predictable desirability of the modification.

M.P.E.P. § 2143.01. As described above, there is no mention in *Osman* of viscosity, much less a suggestion that a foam comprising a liquid phase having a viscosity ranging from 2cP to 5cP; a gas phase comprising at least 90% CO<sub>2</sub>; and wherein the foam has a density less than 0.25 g/ml and half life of greater than 90 seconds would be predictably suitable and/or desired. In order to establish a *prima facie* case of obviousness, the Office must establish the suggestion or motivation in the prior art to prepare the claimed foam.

Therefore, Applicants respectfully submit that the claimed invention is not obvious in view of *Osman et al.* WO 00/72821 (International Application Published Under the PCT, Published 12/07/2000). For the same reasons, the pending claims are also patentable over the following issued patents claiming prior art of *Osman*: U.S. Patent Nos.: 6,942,165; 6,572,873; 7,357,336; 7,025,290.

#### IV. DOUBLE PATENTING

##### 1. U.S. Patent Application Nos.: 10/522,527; 10/890,267; 11/128,265

The Examiner maintained the provisional rejections of:

a) claims 1, 4, 5, 8, 9, 12, 16, 18-20, 27-29, 31, 87 and 88 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1, 6-17, 31 and 33-36 of co-pending Application No. 10/522,527 (Office Action at page 3);

b) claims 1, 8, 18-20, 25 and 27 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1, 7, 10, 11, 12, 14, and 21 of co-pending Application No. 10/890,267 (*Id.*); and

c) claims 1, 8, 9, 18-20, 27, 28, and 31 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1, 7-18, 33, and 35-40 of co-pending Application No. 11/128,265 (Office Action at page 4).

For each of these rejections, the Examiner asserted that "[t]he difference between the two [sets of claims] is the instant invention contains a viscosity-enhancing agent. The addition of a viscosity enhancing [agent] would have been obvious to one of ordinary skill in the art as a means to formulate the foam in a consistency that would achieve the claimed density and half-life of the foam." *See e.g., Id.* at page 3. Applicants respectfully traverse these rejections.

In the context of a double patenting rejection, the obviousness determination under 35 U.S.C. § 103 is modified in one important way. Unlike a § 103 obviousness determination in which all that the prior art reference teaches is relevant, only the *claims*, and not the disclosure, of the patent may be used to formulate a double

patenting rejection. See *In re Braat*, 937 F.2d 589, 594 n.5, 19 U.S.P.Q.2d 1289, 1293 (Fed. Cir. 1991); M.P.E.P. § 804 (III).

While the Examiner concedes that co-pending Application Nos.: 10/890,267 and 11/128,265 are “silent with respect to the viscosity [of the foam],” the Examiner inappropriately relies on the specification to conclude that claims 1, 6-17, 31 and 33-36 of co-pending Application No. 10/522,527 read on the claimed invention, stating that “[i]n looking to the specification [for] support it is noted in paragraph 0047 that the viscosity is in the range of 2.0 to 10.0 cP, preferably 2.0 to 5.0 cP.” Office Action at pages 7-8.

Applicants respectfully submit that nothing in claims 1, 6-17, 31 and 33-36 of co-pending Application No. 10/522,527, claims 1, 7, 10, 11, 12, 14, and 21 of co-pending Application No. 10/890,267, or claims 1, 7-18, 33, and 35-40 of co-pending Application No. 11/128,265 suggests a foam including a liquid phase having a viscosity ranging from 2cP to 5cP. Specifically, the cited *claims* do not disclose any viscosities, yet alone offer any suggestion or motivation that a foam with a liquid phase having a viscosity ranging from 2cP to 5cP would be predictably suitable and/or desired. Therefore, Applicants respectfully request these rejections be withdrawn.

## **2. U.S. Patent Application 11/171,293 (now U.S. Patent No. 7,357,336)**

The Examiner maintained the provisional rejection of claim 64 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 68, 69, 71, 74-76, 80-82, 87, 88, 91-94, 96, 97, 100-102, and 107 of co-pending Application No. 11/171,293 (now U.S. Patent No. 7,357,336). Office Action at page 5.

The Examiner asserted that "[t]he difference between the two [sets of claims] is the cross-sectional dimensions of the passages as claimed in the instant invention. The determination of the cross-sectional dimensions would have been obvious to one of ordinary skill in the art as a means to formulate the foam in a consistency that would achieve the desired results of the claimed foam." *Id.* at pages 5-6.

However, the Examiner also states that "Application 11/171,293 (now US 7,357,336) discloses in claim 1 a foam comprising a sclerosing agent and a gas phase which includes oxygen, carbon dioxide, or a mixture thereof having a density of less than 0.25 g/cm and a half life of greater than 100 secs. Although the reference is silent with respect to the viscosity, it is the position of the examiner that this determination would have been obvious to one of ordinary skill in the art." Office Action at pages 8-9 (emphasis added). Applicants respectfully traverse.

As an initial matter, Applicants are unclear as to which claims of co-pending Application No. 11/171,293 (now U.S. Patent No. 7,357,336) the Examiner bases this rejection on as he refers to "claims 68, 69, 71, 74-76, 80-82, 87, 88, 91-94, 96, 97, 100-102, and 107" on page 5 of the Office Action and refers to "claim 1" on page 8 of the Office Action.

However, regardless of which claim(s) the Examiner relies on, none of the claims of co-pending Application No. 11/171,293 (now U.S. Patent No. 7,357,336), disclose specific viscosities. Additionally, none of the claims of co-pending Application No. 11/171,293 (now U.S. Patent No. 7,357,336) offer any suggestion or motivation that a foam comprising at least 90% carbon dioxide, at least one viscosity enhancing agent,

and having a liquid phase having a viscosity ranging from 2cP to 5cP would be predictably suitable and/or desired.

Therefore, Applicants respectfully request this rejection be withdrawn.

**3. U.S. Patent Application 11/225,860**

The Examiner maintained the provisional rejection of claim 64 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claim 1 of co-pending Application No. 11/225,860. Office Action at page 6.

The Examiner asserted that "[t]he difference between the co-pending applications is the ranges of the cross-sectional passages, density and half-life. In the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists." *Id.* at pages 6-7 (citations omitted). In addition, the Examiner inappropriately relies on the specification to conclude that claim 1 of co-pending Application No. 11/225,860 reads on the claimed invention, stating that "[i]n looking to the specification for examples of the [blood dispersible] gas it is noted in paragraph 0038 that the gas can be carbon dioxide in a concentration of from 10% to 90%." Office Action at page 9. Applicants respectfully traverse.

Applicants respectfully disagree with the Examiner that "[t]he difference between the co-pending applications is the ranges of the cross-sectional passages, density and half-life" and submit that instant claim 64 and claim 1 of co-pending Application No. 11/225,860 additionally differ in that claim 64 recites that the foam comprises "at least 90% carbon dioxide" and "at least one viscosity enhancing agent" and the liquid phase has "a viscosity ranging from 2cP to 5cP." Claim 1 of co-pending Application No. 11/225,860 does not disclose any gas percentages, viscosity enhancing agents, or

specific viscosities. Additionally, the cited claim does not offer any suggestion or motivation that a foam with at least 90% carbon dioxide, at least one viscosity enhancing agent, and a liquid phase having a viscosity ranging from 2cP to 5cP would be predictably suitable and/or desired.

Therefore, Applicants respectfully request this rejection be withdrawn.

**V. CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration of claims 1, 4, 5, 8, 9, 12, 16, 18-20, 25, 27-29, 31, 64, and 87-88 and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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